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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/988,181	12/10/1997	SHINICHI OSHIMA	Q48708	7161

7590

01/13/2004

SUGHRUE MION ZINN MACPEAK & SEAS  
2100 PENNSYLVANIA AVENUE N W  
WASHINGTON, DC 20037

EXAMINER
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GORDON, RAEANN

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 01/13/2004

27

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

08/988,181

Applicant(s)

OSHIMA, SHINICHI

Examiner

Raeann Gorden

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 January 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 12-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All   b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

In view of full reconsideration of the decision rendered by the BPAI and the discovery of prior art material to the consideration of this case, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Connell (1,406,541) in view of Taylor (4,921,255) and Sullivan et al (5,172,936), Matney (4,763,930), and Boggs et al (5,348, 780), each. Regarding claims 12 and 31, the primary reference Connell discloses a box comprising a cover with pictures (icons) and written descriptions of the contents inside the box. These are presented in figures 1 and 2 in three subsections, i.e. the left, center and right portions of the label, each subsection comprises at least one icon, i.e. the cigars on the left, center and right portions. Although Connell discloses cigar information on the box Connell also states "the principle objects of my invention may therefore be said to include, besides the provision of a label adapted or suited for containers holding any of different types of articles" (page 1, lines 75-79). In regards to dependent claims 13-30 and 32-43,

applicant claims specific performance properties of a golf ball on the label such as spin rate, feel, trajectory, etc, which are possessed by all golf balls including the golf ball of Taylor. Golf balls with different playing characteristics, as taught by Taylor (table 1), are usually sold in boxes with labels. While Connell does not specifically disclose a package for golf balls the invention clearly focuses on a label for any packaged item (see claim 1). Also, the written description provided on the box label of Connell includes general or salient characteristics of the contents but does not include performance features as claimed by applicant. However, Sullivan, Matney, and Boggs each teach containers comprising labels that disclose the performance characteristics of the contents inside the container. For example, Sullivan teaches a container comprising a label with indicia disclosing oil specification information (col 4, lines 10-15). Matney teaches a nail polish bottle comprising a label with indicia disclosing properties such as flammability (fig 2). Boggs teaches a multi-use label comprising indicia that discloses high and low energy costs associated with a particular product (col 3, lines 54-64; fig 1). As shown containers comprising indicia describing performance characteristics are old and well known in the art of packaging materials for sale. It would have been obvious for one skilled in the art to label the box of Connell with golf ball performance characteristics taught by Taylor, Sullivan, Matney and Boggs to provide the consumer with a better description of the products.

***Response to Arguments***

Applicant's arguments with respect to claims 12-43 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raeann Gorden whose telephone number is 703-308-8354. The examiner can normally be reached on M-F 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 703-308-1513. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9302.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

Raeann Gorden  
Examiner  
Art Unit 3711

Director's Approval

A handwritten signature in black ink, appearing to read "J. Gorden", is written over a horizontal line.

Rg  
January 5, 2004